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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,738	01/05/2001	Michelle R. Sandholm	ISAA0011	3743

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EXAMINER
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OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/755,738	<b>Applicant(s)</b> SANDHOLM ET AL.	
	<b>Examiner</b> Jonathan Ouellette	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 and 50-85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 and 50-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Claims 49 has been cancelled; therefore Claims 1-48 and 50-85 are currently pending in application 09/755,738.

### Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-48 and 50-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roman (Roman, Ernan, "The Underachieving Database," American Demographics Marketing Tolls Supplement, pp: 48-55, June 1996) in view of Official Notice.
4. As per **independent Claim 1**, Roman discloses a method for developing a multi-channel marketing database in a computer network, which database provides a service offering that enables marketing strategies across multiple customer touchpoints using various communications media and methods (pg.2, direct-mail, telemarketing), said method comprising the steps of: providing a first phase for planning (pg.2); responsive to said providing a first phase for planning, providing, second phase for discovery, comprising business and technical requirements gathering (pgs. 2-3, defining database objectives);

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responsive to said providing a second phase for discovery, providing a third phase for design, comprising reviewing data analysis and determining specifications; responsive to said providing a third phase for design, providing a fourth phase for development comprising creating a physical data model, creating and modifying software programs and performing unit and system test on the computer network (pg.3, design and develop using off-the shelf package and completed trial runs); and responsive to said providing a fourth phase for development, providing a fifth phase for deployment (pg.3, integrated sales database information) comprising the step of ensuring that said multi-channel marketing database is meeting a client's expectations (pg.7, continually updating database with customer information); wherein said multi-channel marketing database comprises a push and pull marketing touchpoint element that collects information data at both push and pull touchpoints, including direct mail, inbound (order taking information) and outbound telemarketing (pg. 2, 4 and 7), and performs a real-time, customer –specific marketing action based on said collected information data (sales rep can access up-to-date customer information through computer system for sales call (pg. 3).

5. Roman fails to expressly disclose touchpoints including email, web sites, and kiosks.
6. However, Official Notice is taken that email, web sites and kiosks were all common tools for completing sales transactions and collecting customer information at the time the invention was made. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include email, web sites and kiosks as touchpoints for collecting customer information to be used for marketing purposes.

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7. As per Claim 2, Roman discloses wherein once said five phases are complete, an on-going support and maintenance mode is provided (pg.7, updating information).
8. As per Claim 3, Roman discloses wherein said method is again followed if enhancement projects are required once said five phases are complete (pg.4, flexible system).
9. As per Claim 4, Roman discloses wherein said planning step further comprises the step of: project formation (pgs. 2-3 equivalent project planning terminology).
10. As per Claim 5, Roman discloses wherein said project formation step further comprises the step of: review client expectations (pgs. 2-3, Sales needs/wants).
11. As per Claim 6, Roman discloses wherein said project formation step further comprises the step of: defining project participants and roles (pgs. 2-3).
12. As per Claim 7, Roman discloses wherein said project formation step further comprises the step of: creating a project plan (pgs. 2-3).
13. As per Claim 8, Roman discloses wherein said planning step further comprises the step of: project initiation (pgs. 2-3).
14. As per Claim 14, Roman discloses wherein said discovery step further comprises the step of: business requirements gathering (pgs. 2-3).
15. As per Claim 15, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's mission statement and business objectives (pgs. 2-3, equivalent to requirements).
16. As per Claim 16, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's organizational structure (pgs. 2-3, equivalent to requirements).

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17. As per Claim 17, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's product and/or service offerings (pgs. 2-3, equivalent to requirements).
18. As per Claim 18, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's target market and competition (pgs. 2-3, equivalent to requirements).
19. As per Claim 19, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's campaign management strategies (pgs. 2-3, equivalent to requirements).
20. As per Claim 20, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's critical success factors (pgs. 2-3, equivalent to requirements).
21. As per Claim 21, Roman discloses wherein said discovery step further comprises the step of: multi-channel marketing database requirements gathering (pgs. 2-3).
22. As per Claim 22, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing multi-channel marketing database reports and templates (pgs. 2-3).
23. As per Claim 23, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing a client's additional requirements (pgs. 2-3).

24. As per Claim 24, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing multi-channel marketing database data feeds (pgs. 1-9).
25. As per Claim 25, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing multi-channel marketing database calculations (pgs. 1-9).
26. As per Claim 26, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing multi-channel marketing database update requirements (pgs. 1-9).
27. As per Claim 27, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing multi-channel marketing database access requirements (pgs. 1-9).
28. As per Claim 28, Roman discloses wherein said discovery step further comprises the step of: technical requirements gathering (pgs. 2-3).
29. As per Claim 29, Roman discloses wherein said technical requirements gathering step further comprises the step of: reviewing connectivity, user access, and support requirements (pgs. 1-9).
30. As per Claim 30, Roman discloses wherein said technical requirements gathering step further comprises the step of: reviewing retention, backup, and security requirements (pgs. 1-9).
31. As per Claim 35, Roman discloses wherein said design step further comprises the step of: ordering multi-channel marketing database software (pgs. 2-3).

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32. As per Claim 38, Roman discloses wherein said conducting a design meeting step further comprises the step of: data mapping (pgs. 1-9).
33. As per Claim 39, Roman discloses wherein said conducting a design meeting step further comprises the step of: data analysis review (pgs. 1-9).
34. As per Claim 40, Roman discloses wherein said conducting a design meeting step further comprises the step of: updating database specifications (pgs. 1-9).
35. As per Claim 41, Roman discloses wherein said conducting a design meeting step further comprises the step of: determining calculations specifications (pgs. 1-9).
36. As per Claim 42, Roman discloses wherein said conducting a design meeting step further comprises the step of: determining mapping, report, and query template specifications (pgs. 1-9).
37. As per Claim 48, Roman discloses wherein said development step further comprises the step of: analyzing test load and update files (pgs.2-3, design and development).
38. As per Claim 50, Roman discloses wherein said development step further comprises the step of: creating/modifying specifications (pgs. 2-3).
39. As per Claim 51, Roman discloses wherein said creating/ modifying specifications step further comprises the step of: performing data preparation and determining integration specifications for initial load and on-going updates (pgs.2-3, design and development).
40. As per Claim 52, Roman discloses wherein said creating/ modifying specifications step further comprises the step of: developing database management specifications for initial load and on-going updates (pgs.2-3, design and development).



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41. As per Claim 53, Roman discloses wherein said creating/ modifying specifications step further comprises the step of: developing report specifications (pgs.2-3, design and development).
42. As per Claim 54, Roman discloses wherein said creating/ modifying specifications step further comprises the step of: developing query templates specifications (pgs.2-3, design and development).
43. As per Claim 55, Roman discloses wherein said creating/ modifying specifications step further comprises the step of: creating a test database (pgs. 2-3).
44. As per Claim 56, Roman discloses wherein said development step further comprises the step of: creating one or more unit and system test plans (pgs. 2-3).
45. As per Claim 57, Roman discloses wherein said creating one or more unit and system test plans step further comprises the step of: data preparation and developing integration test plans for initial load and on-going updates (pgs.2-3, design and development).
46. As per Claim 58, Roman discloses wherein said creating one or more unit and system test plans step further comprises the step of: developing database management test plans for initial load and on-going updates (pgs.2-3, design and development).
47. As per Claim 59, Roman discloses wherein said creating one or more unit and system test plans step further comprises the step of: developing report test plans (pgs.2-3, design and development).
48. As per Claim 60, Roman discloses wherein said creating one or more unit and system test plans step further comprises the step of: developing query template test plans (pgs.2-3, design and development).

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49. As per Claim 61, Roman discloses wherein said development step further comprises the step of: creating/modifying programs and routines (pgs.2-3, design and development).
50. As per Claim 62, Roman discloses wherein creating/modifying programs and routines step further comprises the step of: data preparation and developing integration programs for initial load and on-going updates (pgs.2-3, design and development).
51. As per Claim 63, Roman discloses wherein creating/modifying programs and routines step further comprises the step of: developing database management programs for initial load and on-going updates (pgs.2-3, design and development).
52. As per Claim 64, Roman discloses wherein creating/modifying programs and routines step further comprises the step of: developing report programs (pgs.2-3, design and development).
53. As per Claim 65, Roman discloses wherein creating/modifying programs and routines step further comprises the step of: developing query templates (pgs.2-3, design and development).
54. As per Claim 66, Roman discloses wherein said development step further comprises the step of: performing unit/system tests (pgs. 2-3).
55. As per Claim 67, Roman discloses wherein said performing unit/ system tests step further comprises the step of: data preparation and developing integration tests for initial load and on-going updates (pgs.2-3, design and development).
56. As per Claim 68, Roman discloses wherein said performing unit/ system tests step further comprises the step of: developing database management tests for initial load and on-going updates (pgs.2-3, design and development).
57. As per Claim 69, Roman discloses wherein said performing unit / system tests step further comprises the step of: developing reports (pgs.2-3, design and development).

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58. As per Claim 70, Roman discloses wherein said performing unit / system tests step further comprises the step of: developing query templates (pgs.2-3, design and development).
59. As per Claim 71, Roman discloses wherein said development step further comprises the step of: processing test data and populating a test database (pgs.2-3, design and development).
60. As per Claim 72, Roman discloses wherein said development step further comprises the step of: establishing retention, backup, and security procedures (pgs.2-3, design and development).
61. As per Claim 73, Roman discloses wherein said development step further comprises the step of: configuring internal end-user tools (pgs.2-3, design and development).
62. As per Claim 79, Roman discloses wherein said deployment step further comprises the step of: analyzing live load files (pgs. 2-3).
63. As per Claim 80, Roman discloses wherein said deployment step further comprises the step of: creating a live database (pgs. 2-3, integrating Sales Data).
64. As per Claim 81, Roman discloses wherein said creating a live database step further comprises the step of: processing live data and populating a live database (pgs. 2-3).
65. As per Claim 82, Roman discloses wherein said deployment step further comprises the step of: carrying out a deployment plan (pgs. 2-3).
66. As per **independent Claim 85**, Roman discloses a method for developing a multi-channel marketing database in a computer network, which database provides a service offering that enables multi-channel marketers to analyze, create, track, control, coordinate, and execute marketing strategies across multiple customer touchpoints using various communications media and methods (pg.2, direct-mail, telemarketing), said method comprising the steps of:

providing a first phase for planning (pg.2) in which a team is identified from both a company and a client side; responsive to said providing a first phase for planning, providing, second phase for discovery (pgs. 2-3, defining database objectives), where both business and technical requirements are identified and documented in a discovery document (pgs. 2-3); responsive to said providing a second phase for discovery, providing a third phase for design to determine specification for data mapping, update rules, calculations, reports, and campaign management, wherein developed information is documented in a design document (common company project planning process); responsive to said providing a third phase for design, providing a fourth phase for development in which said company creates a physical data model and unit and system test plans for the computer network, creates and modifies actual software programs and routines on the computer network, and on the computer network performs unit and system tests based upon specifications outlines in said design document; wherein said company also establishes retention, back-up, and security procedures and configures end-user tools; and wherein output from this phase is a deployment plan which is shared with said client (pg.3, design and develop using off-the shelf package and completed trial runs); and responsive to said providing a fourth phase for development, providing a fifth phase for deployment; wherein said company also analyzes final load files from said client and loads a database with live data; wherein said company provides end-user tool training and access to data as outlined in said deployment plan (pg.3, integrated sales database information); wherein said multi-channel marketing database comprises a push and pull marketing touchpoint element that collects information data at both push and pull touchpoints, including direct mail, inbound and outbound telemarketing (pg. 2, 4 and 7), and

performs a real-time, customer –specific marketing action based on said collected information data (sales rep can access up-to-date customer information through computer system for sales call (pg. 3).

67. Roman fails to disclose each and every project management step disclosed by the instant invention, to include: planning a meeting, holding a meeting, obtaining approval of project steps from the customer, and providing a post project review to the customer.
68. However, Official Notice is Taken that all of these steps were common business project plan elements/processes at the time the invention was made, and it would have been obvious to one of ordinary skill in the art to include these steps when integrating the marketing database development plan as disclosed by Roman, for the purpose of more effectively implementing the project plan according to common project plan techniques and strategies.
69. Furthermore, Roman fails to expressly disclose touchpoints including email, web sites, and kiosks.
70. However, Official Notice is taken that email, web sites and kiosks were all common tools for completing sales transactions and collecting customer information at the time the the invention was made. Therefore, it would have been obvious for one or ordinary skill in the art at the time the invention was made to include email, web sites and kiosks as touchpoints for collecting customer information to be used for marketing purposes.
71. As per Claim 9, Roman discloses wherein said project initiation step further comprises the step of: planning a client kick-off meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

72. As per Claim 10, Roman discloses wherein said project initiation step further comprises the step of: reviewing client executive sponsor responsibilities (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
73. As per Claim 11, Roman discloses wherein said project initiation step further comprises the step of: establishing project communication standards (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
74. As per Claim 12, Roman discloses wherein said project initiation step further comprises the step of: preparing company team members (marketing dept or IS dept) for discovery (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
75. As per Claim 13, Roman discloses wherein said discovery step further comprises the step of: conducting a client kick-off meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
76. As per Claim 31, Roman discloses wherein said technical requirements gathering step further comprises the step of: reviewing future migration requirements (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
77. As per Claim 32, Roman discloses wherein said discovery step further comprises the step of: discovery document compilation (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
78. As per Claim 33, Roman discloses wherein said discovery step further comprises the step of: discovery document delivery (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

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79. As per Claim 34, Roman discloses wherein said design step further comprises the step of:  
preparing company team members for design (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
80. As per Claim 36, Roman discloses wherein said design step further comprises the step of:  
planning a design meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
81. As per Claim 37, Roman discloses wherein said design step further comprises the step of:  
conducting a design meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
82. As per Claim 43, Roman discloses wherein said conducting a design meeting step further comprises the step of: determining campaign management specifications and schedules (pgs. 1-9).
83. As per Claim 44, Roman discloses wherein said design step further comprises the step of:  
design document compilation (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
84. As per Claim 45, Roman discloses wherein said design step further comprises the step of:  
design document delivery (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
85. As per Claim 46, Roman discloses wherein said development step further comprises the step of: planning a development meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

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86. As per Claim 47, Roman discloses wherein said development step further comprises the step of: conducting a development meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
87. As per Claim 74, Roman discloses wherein said development step further comprises the step of: preparing for deployment tool training (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
88. As per Claim 75, Roman discloses wherein said development step further comprises the step of: preparing for a deployment plan (pgs.2-3, sales data integration).
89. As per Claim 76, Roman discloses wherein said development step further comprises the step of: preparing for a deployment meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
90. As per Claim 77, Roman discloses wherein said deployment step further comprises the step of: planning a deployment meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
91. As per Claim 78, Roman discloses wherein said deployment step further comprises the step of: conducting a deployment meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
92. As per Claim 83, Roman discloses wherein said deployment step further comprises the step of: conducting a company post-project review (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).



93. As per Claim 84, Roman discloses wherein said deployment step further comprises the step of: conducting a client post-project review (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

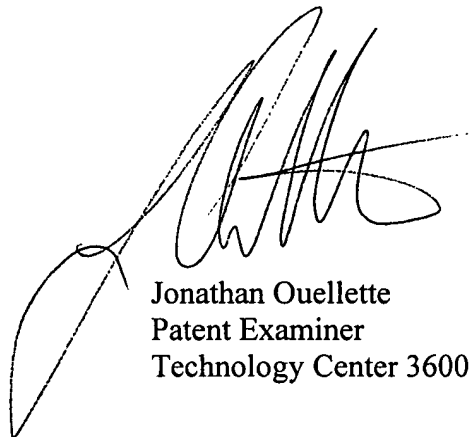
***Response to Arguments***

94. Applicant's arguments filed 8/15/2006 have been considered, but are moot in view of the new ground(s) of rejection.
95. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
96. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Conclusion*

97. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
98. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
99. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

October 23, 2006



Jonathan Ouellette  
Patent Examiner  
Technology Center 3600